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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/434,645 | 11/05/1999 | DAVID B. LOEPER | D5009-00002 | 4199 |

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EXAMINER

KYLE, CHARLES R

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3624

DATE MAILED: 06/21/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------|------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/434,645 | LOEPER, DAVID B. | |
| Examiner | Art Unit | | |
| Charles R Kyle | 3624 | | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 25 March 2002.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-21 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-21 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4) Interview Summary (PTO-413) Paper No(s). 12.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

DETAILED ACTION

Continued Prosecution Application

The request filed on March 25, 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/434645 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-19 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by *College Accounting, Seventh Edition*.

Concerning Claim 1, *College Accounting, Seventh Edition* discloses the invention as claimed, including in a method for evaluating financial plans, the steps of:

Receiving from a user a predetermined initial value of an investment (Page 647, “Investment of Cash by Partner”), at least one predetermined contribution amount at a predetermined contribution time (Page 651, lines 1-5 and 31-36), and at least one predetermined withdrawal amount at a predetermined withdrawal time subsequent to the predetermined contribution time (Page 648, lines 1-9); (Page 651, lines 1-5 and 31-36);

Calculating the change in said predetermined initial value of an investment over a time interval (Page 161, lines 8-10) based on changes in value over a first historical time interval (Page 161, lines 8-10) to obtain a changed investment value (Page 649, lines 1-10);

Updating the changed investment value based on selected investment assumptions (Page 651, lines 31-36) to obtain a further changed investment value (Page 640, line 11 to Page 641, line 19) (End of Fiscal Year 19X3);

Calculating the change in the further changed investment value over a second time interval (Fiscal Year 19X4) based on changes over a second historical time interval to obtain a further investment value, and

Repeating said steps of calculating updating and again calculating with respect to a third historical and a fourth historical, respectively (Fiscal Years 19X5 and 19X6) respectively; and

After at least one of the calculations, adjusting the investment value based on at least one of said contribution amount and said withdrawal amount (Page 648, lines 1-9; Page 650, lines 12-28).

Concerning Claims 2, 8 and 14, *College Accounting* discloses the presentation of results at Page 453, "Statement of Owner's Equity".

Regarding Claims 3, 9 and 15, *College Accounting* discloses multiple asset categories and distinct historical data at Page 651, closing of net income from period statements to Owners' Capital Accounts.

As to Claims 4, 10 and 16, *College Accounting* discloses comparison of results of calculation to a goal at Page 1092-1095, Budget Performance report.

Concerning Claims 5, 11 and 17, *College Accounting* discloses adjustment of results for tax effects at Pages 736-741 and 757-761.

With respect to Claims 6, 12 and 18, *College Accounting* teaches the entry of initial investment values and allocation to asset categories at Pages 646-647, particularly lines 1-10 and 31-35.

As to Claim 19, *College Accounting* discloses identification of time intervals at result presentation at Page 653, lines 25-40.

Regarding Claim 21, *College Accounting* discloses changing an asset allocation after a selected number of time intervals and using a changed allocation in subsequent calculations at Page 653, lines 31-40 (adjusted capital accounts carried forward to next period).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over *College Accounting*.

Concerning Claim 20, *College Accounting, Seventh Edition* discloses the invention substantially as claimed. See the discussion of Claim 4 above. *College Accounting, Seventh Edition* does not specifically disclose having as a goal a specified sum after a number of years. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of *College Accounting, Seventh Edition* to facilitate determination of reaching a goal because this would have allowed an

investor to determine whether the investment provided returns to meet the investor's financial needs.

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al.

As to Claims 1, 7 and 13, Jones et al disclose the invention substantially as claimed, including system, method and storage medium for evaluating financial plans (Col. 5, line 50 to Col. 7, line 60) which includes:

Receiving from a user a predetermined initial value of an investment (Col. 18, lines 27-29) at least one predetermined contribution amount at a predetermined contribution time (Col. 5, line 52 to Col. 6, line 7) and at least one predetermined withdrawal amount at a predetermined withdrawal time subsequent to the predetermined contribution time (Col. 17, lines 45-55);

Calculating the change in a predetermined initial value of an investment over a time interval based on changes over a first historical time interval to obtain a changed investment value (Fig. 4; Col. 12, lines 54-64; Fig. 6; Col. 16, lines 12-24);

updating the changed investment value based on selected investment assumptions to obtain a further changed investment value (Col 20, lines 8-30);

calculating the change in the changed initial value of an investment to obtain a further changed investment value (Col. 18, lies 27-49);

repeating the calculations with respect to successive historical time periods (Col. 18, lines 27-29);

after at least one of the calculations, adjusting the investment based on at least one of a contribution amount and a withdrawal amount (Fig. 7; Col. 17, line 45 to Col. 18, line 48).

Jones suggests the use of historical data in the prediction of performance at Col. 3, lines 55-61, where the sensitivity of a financial product to movements of various common economic factors is discussed. Such sensitivity information would be obtained from historical data showing the response of an investment to historical economic forces.

Jones et al do not specifically disclose the use of such historical data from particular second, third and fourth historical time intervals, although they do suggest the specific use of historical data in calculation of investment value as noted above. It would have been obvious to one of ordinary skill in the art at the time of the invention to have used additional and different historical data because this would have produced more accurate investment values in an iterative process of stepwise refined calculations. This need for such flexibility is clearly suggested in the disclosure of a dynamic approach to re-balancing to maximize returns at Col. 18, lines 27-48. Failure to have made such historically based adjustments would have produced a rigid and likely inaccurate process of investment valuation.

Concerning Claims 2, 8 and 14, Jones et al disclose the presentation of results at Col. 4, lines 24-34 and Col. 11, lines 7-10.

Regarding Claims 3, 9 and 15, Jones et al disclose multiple asset categories and distinct historical data at Fig. 4 and Col. 12, line 54 to Col. 13, line 41.

As to Claims 4, 10 and 16, Jones et al disclose comparison of results of calculation to a goal at Col. 12, lines 9-31.

Concerning Claims 5, 11 and 17, Jones et al disclose adjustment of results for tax effects at Col. 10, lines 18-53.

With respect to Claims 6, 12 and 18, Jones et al teach the entry of initial investment values and allocation to asset categories at Col. 5, line 50 to Col. Col. 7, line 10.

As to Claim 19, Jones et al disclose identification of time intervals at result presentation at Col. 1, lines 10-13.

Concerning Claim 20, Jones et al disclose having as a goal a specified sum after a number of years at Col. 12, lines 15-17.

Regarding Claim 21, Jones et al disclose changing an asset allocation after a selected number of time intervals and using a changed allocation in subsequent calculations at Col. 12, lines 24-28.

Response to Arguments

Applicant's arguments filed November 26, 2001 have been fully considered but they are not persuasive.

Applicant's substantive arguments begin by stating that his invention looks at past performance which differs from *Jones* in that *Jones* looks only to prediction of future performance. At pages 1-3 of Applicant's specification, the invention is described in terms of prediction (e.g. page 2, first full paragraph) and whether an investor "will meet the investor's financial goals" (page 3, second full paragraph). Clearly, Applicant's invention has a similar utility as *Jones* in looking to the future based on past performance; looking only at past performance in a vacuum might be of interest but of little use to investors. Applicant argues at length that *Jones* looks only to the future; *Jones* inherently makes use of such historical data for determining asset performance. See the discussion of Claim 1 above.

Applicant argues that Jones fails to use data from more than one period but provides no substantive argument to refute the examiners argument regarding multiple time periods set forth above.

As to Applicant's arguments to the specifics of the portfolio rebalancing, the examiner did not rely on Jones for the specifics of rebalancing but rather to show that dynamic iterative process was desirable for accuracy of analysis and prediction. Clearly, additional analysis of more and changing historical data would yield a more correct estimation of financial plan performance as compared to less.

As to Applicant's argument at page 3, first full paragraph, Applicant argues that Jones requires an assessment of risk tolerance. Nonetheless, Jones teaches the features as set forth above in addition the a risk assessment feature.

Rejections of Claims 7, 13, 2, 8 and 14 stand rejected for the same reasons as Claim 1.

As to arguments regarding claims 3, 9 and 14, they argue limitations not present in the claims.

As to arguments regarding claims 5,11 and 17, they argue limitations not present in the claims.

Rejections of Claims 6, 12 and 18 stand rejected for the same reasons as Claim 1.

Concerning arguments about claim 19, Applicants claims recite "evaluating financial plan" in the preamble, which feature is not necessary to give life and breath to the claim. Such a feature does not limit the claim as recited and the claim is interpreted more broadly. As to other arguments regarding historical performance see the discussions set forth above.

Rejections of Claims 20 and 21 stand rejected for the same reasons as Claim 1.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles R Kyle whose telephone number is (703) 305-4458. The examiner can normally be reached on M-F 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

crk
crk
June 11, 2002

✓
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